UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,704	11/09/1999	DANIEL R. BAUM	11087-004001	7040

31688 7590 10/28/2003

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

EXAMINER	
FOSTER, JUSTIN B	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/436,704	BAUM, DANIEL R.	
	Examiner	Art Unit	
	Justin Foster	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-155* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-155* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-8, 12, 13, 30-42, 44-48, 57, 58, 80-87, 91, 92, 107-115 and 132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund, *et al.* (5,666,215) in view of Johnson (6,052,670). With regard to claim 1, Fredlund discloses a computer-implemented method of distributing image prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. Fredlund further discloses, in lines 42-44 of column 2, the step of sending the prints to the designated recipients. The difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of

ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient.

3. With regard to claim 2, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. This allows for the images in a first recipient's image set to differ from the images in a second recipient's image set.

4. With regard to claim 3, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This allows for a user, if so desired, to select print parameters of a first recipient's image set that differ from printing parameters of a second recipient's image set.

5. With regard to claim 4, Fredlund in view of Johnson discloses the invention as stated in claim 3. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

6. With regard to claim 5, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This would allow for a user, if so desired, to select print parameters that differ among images within an image set.

7. With regard to claim 6, Fredlund in view of Johnson discloses the invention as stated in claim 5. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

8. With regard to claim 7, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 38-47 of column 5, the selection by the user of an arbitrary set of one or more images.

9. With regard to claim 8, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 42-44 of column 2, the method wherein a single entity, i.e. the photofinisher, performs the steps of receiving the images, completing the order (printing) and sending the prints (distributing).

10. With regard to claim 12, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 42-44 of column 2, the method where the "photofinisher completes the order and sends the prints to the designated recipient". This is an integrated process for printing and distributing.

11. With regard to claim 13, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 42-44 of column 2, the method wherein a single entity, i.e. the photofinisher, performs the steps of completing the order (printing) and sending the prints (distributing).

12. With regard to claim 30, Fredlund in view of Johnson discloses the invention as stated in claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the recipient to comprise an individual if the user desired to send the order to an individual.

13. With regard to claim 31, Fredlund in view of Johnson discloses the invention as stated in claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the recipient to comprise a business entity if the user desired to send the order to a business entity.

14. With regard to claim 32, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 22-24 of column 6, that "the order information interface includes an area 70 for entering the shipping address for the order". As such, the recipient comprises an address.

15. With regard to claim 33, Fredlund in view of Johnson discloses the invention as stated in claim1. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the plurality of recipients to comprise an individual, an address, a business entity, or any combination thereof in accordance with the desired order of the user.

16. With regard to claim 34, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 40-42 of column 2, that a "designated recipient may

be different from the customer placing the order." This allows for at least one of the specified recipients to be different from a user from whom the order was received.

17. With regard to claim 35, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund further discloses, in lines 32-34, the use of a "Place Order" button that advances the user to the payment interface screen. Use of this button after placing a single order allows the order sequence to comprise a single transaction sequence.

18. With regard to claim 36, Fredlund in view of Johnson discloses the invention as stated in claim 35. Fredlund further discloses, in lines 41-47 of column 6, a payment interface screen for entering a payment method. This inherently comprises a single charge to a financial instrument.

19. With regard to claim 37, Fredlund in view of Johnson discloses the invention as stated in claim 36. Fredlund further discloses, in lines 41-47 of column 6, a payment interface screen for selecting a credit card as a financial instrument.

20. With regard to claim 38, Fredlund in view of Johnson discloses the invention as stated in claim 35. Fredlund further teaches, in lines 52-53 of column 6, that a single transaction sequence is terminated by a click of a "send button". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single transaction sequence to be terminated by a click of an "order" button since the claimed "order button" and the disclosed "send button" are functionally equivalent.

21. With regard to claim 39, Fredlund discloses a computer-implemented method of distributing image prints, which are inherently physical manifestations of digital content, to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images from a digital image file, which is inherently a set of digital content, to be

ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images, which is inherently generating a physical manifestation of the digital content in the recipient's digital content set for each of the plurality of recipients specified in the received order. Fredlund further discloses, in lines 42-44 of column 2, the step of sending the prints, which are inherently the physical manifestations, to the designated recipients. The difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient.

22. With regard to claim 40, Fredlund in view of Johnson discloses the invention as stated in claim 39. Fredlund further discloses wherein the set of digital content comprises one or more digital images, as stated in lines 38-47 of column 5.

23. With regard to claim 41, Fredlund in view of Johnson discloses the invention as stated in claim 40. Fredlund further discloses, in lines 18-30 of column 7, the printing of the digital images onto photographic paper. This is a method wherein the physical manifestaion of the set of digital content comprises photographic prints of the one or more digital images.

24. With regard to claim 42, Fredlund in view of Johnson discloses the invention as stated in claim 39. Fredlund further discloses, in lines 49-50 of column 2, the option of selecting picture frames for the prints. This allows for the physical manifestation of digital content to comprise a framed photographic print of a digital image.

25. With regard to claim 44, Fredlund in view of Johnson discloses the invention as stated in claim 39. Fredlund further discloses, in line 5 of column 5, the option to add text to the image. This option comprises a composition of the digital images and textual content.

26. With regard to claim 45, Fredlund in view of Johnson discloses the invention as stated in claim 40. Fredlund further discloses, in lines 49-51 of column 5, the use of image bearing items, which are artifacts bearing a digital image.

27. With regard to claim 46, Fredlund in view of Johnson discloses the invention as stated in claim 45. Fredlund further discloses, in lines 49-51 of column 5, the use of image bearing, or artifact bearing, items such as "coffee mugs and T-shirts" which are novelty items.

28. With regard to claim 47, Fredlund in view of Johnson discloses the invention as stated in claim 45. Fredlund further discloses, in lines 49-51 of column 5, the use of image bearing, or artifact bearing, items such as a coffee mug or a shirt.

29. With regard to claim 48, Fredlund in view of Johnson discloses the invention as stated in claim 39. Fredlund further discloses, in lines 38-47 of column 5, the invention as stated in claim

39 wherein the set of digital content comprises one or more digital images, which are graphical content.

30. With regard to claim 57, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund further discloses, in lines 38-47 of column 5, the invention as stated in claim 48 wherein the graphical and/or textual content comprises digital images.

31. With regard to claim 58, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund further discloses, in lines 38-47 of column 5, the invention as stated in claim 48 wherein the graphical and/or textual content comprises digital images, which are computer-generated content.

32. With regard to claim 80, Fredlund discloses a print distribution system comprising the following elements. Fredlund discloses in lines 19 of column 3 through 47 of column 5, a front-end computer sub-system for receiving an for image prints. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further discloses, in lines 18-30 of column 7, a printing sub-system for filling the order by printing the selected images. Fredlund further discloses, in lines 42-44 of column 2, the distribution sub-system for sending the prints to the designated recipients. The difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson

discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient.

33. With regard to claim 81, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. This allows for the images in a first recipient's image set to differ from the images in a second recipient's image set.

34. With regard to claim 82, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This allows for a user, if so desired, to select print parameters of a first recipient's image set that differ from printing parameters of a second recipient's image set.

35. With regard to claim 83, Fredlund in view of Johnson discloses the invention as stated in claim 82. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-

66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

36. With regard to claim 84, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This would allow for a user, if so desired, to select print parameters that differ among images within an image set.

37. With regard to claim 85, Fredlund in view of Johnson discloses the invention as stated in claim 84. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

38. With regard to claim 86, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 38-47 of column 5, the selection by the user of an arbitrary set of one or more images.

39. With regard to claim 87, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 42-44 of column 2, the method wherein a single entity, i.e. the photofinisher, controls the front-end computer sub-system, the printing sub-system and the distribution sub-system.

40. With regard to claim 91, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 42-44 of column 2, the method where the

"photofinisher completes the order and sends the prints to the designated recipient". This means that the printing sub-system and the distribution sub-system are integrated.

41. With regard to claim 92, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 42-44 of column 2, the method wherein a single entity, i.e. the photofinisher, controls the printing sub-system and the distribution sub-system.

42. With regard to claim 107, Fredlund in view of Johnson discloses the invention as stated in claim 80. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the recipient to comprise an individual if the user desired to send the order to an individual.

43. With regard to claim 108, Fredlund in view of Johnson discloses the invention as stated in claim 80. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the recipient to comprise a business entity if the user desired to send the order to a business entity.

44. With regard to claim 109, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 22-24 of column 6, that "the order information interface includes an area 70 for entering the shipping address for the order". As such, the recipient comprises an address.

45. With regard to claim 110, Fredlund in view of Johnson discloses the invention as stated in claim80. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the plurality of recipients to comprise an individual, an address, a business entity, or any combination thereof in accordance with the desired order of the user.

46. With regard to claim 111, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 40-42 of column 2, that a "designated recipient may be different from the customer placing the order." This allows for at least one of the specified recipients to be different from a user from whom the order was received.

47. With regard to claim 112, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund further discloses, in lines 32-34, the use of a "Place Order" button that advances the user to the payment interface screen. Use of this button after placing a single order allows the order sequence to comprise a single transaction sequence.

48. With regard to claim 113, Fredlund in view of Johnson discloses the invention as stated in claim 112. Fredlund further discloses, in lines 41-47 of column 6, a payment interface screen for entering a payment method. This inherently comprises a single charge to a financial instrument.

49. With regard to claim 114, Fredlund in view of Johnson discloses the invention as stated in claim 113. Fredlund further discloses, in lines 41-47 of column 6, a payment interface screen for selecting a credit card as a financial instrument.

50. With regard to claim 115, Fredlund in view of Johnson discloses the invention as stated in claim 112. Fredlund further teaches, in lines 52-53 of column 6, that a single transaction sequence is terminated by a click of a "send button". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single transaction sequence to be terminated by a click of an "order" button since the claimed "order button" and the disclosed "send button" are functionally equivalent.

51. With regard to claim 132, Fredlund discloses a computer-implemented method of ordering image prints for a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection, from a user's computer system, which is inherently client system, of a set of one or more images to be ordered from a host system. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further teaches, in lines 52-53 of column 6, that a single transaction sequence is terminated by a click of a "send button". The difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient.

52. Claims 9-11 and 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Shiota, *et al.* (6,324,521). With regard to claim 9, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose the method wherein the functions of receiving, printing and

distributing among two or more different entities. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server receives an order for image prints and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the functions of receiving, printing, and distributing of Fredlund and Johnson to be dispersed among two or more different entities as taught by Shiota. This would provide a prompt service to a customer because each entity could be tailored to a specific task.

53. With regard to claim 10, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose the receiving of an order by an enterprise providing a web front-end. Shiota teaches, in lines 21-32 of column 2, the use of a website on the Internet through which an order is transferred from a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive an order by an enterprise providing a web front-end. This would allow for the order to be automatically received in the correct predetermined data format.

54. With regard to claim 11, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 10. Shiota further discloses, in lines 65 of column 1 through 9 of column 2, the method of distributing image prints wherein a center server receives a "printing service order via the network" using a web front end as described in lines 21-32 of column 2, and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for printing or distributing, or both, to be performed by a fulfillment enterprise different than the enterprise providing the web front-end. This would provide a prompt service to a customer.

55. With regard to claim 88, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund in view of Johnson does not disclose dispersing the front-end computer sub-system, the printing sub-system, and the distribution sub-system among two or more different entities. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server receives an order for image prints and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the front-end computer sub-system, the printing sub-system, and the distribution sub-system to be dispersed among two or more different entities. This would provide a prompt service to a customer.

56. With regard to claim 89, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund in view of Johnson does not disclose controlling the front-end computer sub-system by an enterprise providing a web front-end. Shiota teaches, in lines 21-32 of column 2, the use of a website on the Internet through which an order is transferred from a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to control the front-end computer sub-system by an enterprise providing a web front-end. This would allow for the order to be automatically received in the correct predetermined data format.

57. With regard to claim 90, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 89. Shiota further discloses, in lines 65 of column 1 through 9 of column 2, the method of distributing image prints wherein a center server receives a "printing service order via the network" using a web front end as described in lines 21-32 of column 2, and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the printing sub-system

or the distribution sub-system, or both, to be controlled by a fulfillment enterprise different than the enterprise providing the web front-end. This would provide a prompt service to a customer.

58. Claims 14 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Tackbary, *et al.* (5,555,496). With regard to claim 14, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose the printing and distributing being performed by different entities. Tackbary teaches, in lines 55 of column 12 through 3 of column 13, the use of a card distribution center to print a graphical card design on blank paper stock and the delivery of said cards via a different entity, with examples of said different entity given in lines 9-11 of column 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made for printing and distributing to be performed by different entities. This would allow for both printing and distributing to be handled by an entity specifically tailored for each task respectively.

59. With regard to claim 93, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund in view of Johnson does not disclose the printing sub-system and the distribution sub-system being controlled by different entities. Tackbary teaches, in lines 55 of column 12 through 3 of column 13, the use of a card distribution center to print a graphical card design on blank paper stock and the delivery of said cards via a different entity, with examples of said different entity given in lines 9-11 of column 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the printing sub-system and the distribution sub-system to be controlled by different entities. This would allow for both printing and distributing to be handled by an entity specifically tailored for each task respectively.

60. Claim 15-25, 27, 28, 94-102, 104 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok (6,157,436). With regard to claim 15, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. This would allow for each recipient's order to be prepared separately which ensures that each order is delivered to the proper recipient.

61. With regard to claim 16, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 15. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a set of one or more images in each sub-order in order to fulfill each recipient's order.

62. With regard to claim 17, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 15. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. This will print a run of prints associated with a specified recipient since the images associated with each recipient are contained in the order.

63. With regard to claim 18, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 17. Cok further teaches, in lines 49-51 of column 9, the use of a sub-order header for each sub-order that includes "a unique identification of the customer order from which the sub-order was derived". Fredlund further teaches, in lines 12-14 of column 8,

the printing of address labels along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a destination identifier that identifies the specified recipient for a corresponding run of prints. This would make it easy to keep track of the separate sub-orders.

64. With regard to claim 19, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 18. Cok further teaches, in lines 49-51 of column 9, that sub-order header, the use of "a unique identification of the customer order from which the sub-order was derived", which delimits a corresponding sub-order. Fredlund further teaches, in lines 12-14 of column 8, the printing of an address label, which is a destination identifier, along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for a destination identifier to delimit a corresponding sub-order. This would make it easy to keep track of the separate sub-orders.

65. With regard to claim 20, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 18. Fredlund further discloses, in lines 12-14 of column 8, the printing of address labels, which inherently contains a shipping address, along with the image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the destination identifier to comprise a shipping address in order for the order to be properly shipped.

66. With regard to claim 21, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 18. Fredlund further teaches, in lines 34-35 of column 6 that "The settings and image selected on screen 50 remain the same unless specifically changed by

the user." This shows that the print parameters of a first image in a sub-order could differ from the print parameters of a second image in the sub-order if the user so desired.

67. With regard to claim 22, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 21. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

68. With regard to claim 23, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 15. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. This is a process of instantiating a copy of the image for each recipient designated to receive a print of that image.

69. With regard to claim 24, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 23. Fredlund further discloses, in lines 26-30 of column 7, the producing of Photo CD's from the ordered images. This is a case wherein an instantiated copy comprises a digital image file since Photo CD's must contain digital image files.

70. With regard to claim 25, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 15. Cok further discloses, in lines 62 of column 2 through 7 of column 3, that a processor, which is a first entity, divides an order into sub-orders, and a plurality of output systems, one of which is a second entity, generates one or more image copies.

71. With regard to claim 27, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 25. Fredlund further teaches, in lines 19-41 of column 3, the use of a retail outlet, which is inherently a goods / service provider, to distribute orders. It would

have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a goods / service provider enterprise in order to provide easy access to the customer.

72. With regard to claim 28, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 25. Fredlund further teaches, in lines 19-41 of column 3, the use of a drugstore or supermarket to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a supermarket, a drugstore, a post office, or an online grocer in order to provide easy access to the customer.

73. With regard to claim 94, Fredlund in view of Johnson discloses the invention as stated in claim 80. Fredlund in view of Johnson does not disclose a sub-system for dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the printing sub-system to comprise a sub-system for dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. This would allow for each recipient's order to be prepared separately.

74. With regard to claim 95, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 94. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the printing sub-system to print a set of one or more images in each sub-order in order to fulfill each recipient's order.

75. With regard to claim 96, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 94. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. This will print a run of prints associated with a specified recipient since the images associated with each recipient are contained in the order.

76. With regard to claim 97, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 96. Cok further teaches, in lines 49-51 of column 9, the use of a sub-order header for each sub-order that includes "a unique identification of the customer order from which the sub-order was derived". Fredlund further teaches, in lines 12-14 of column 8, the printing of address labels along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was for the printing sub-system to print a destination identifier that identifies the specified recipient for a corresponding run of prints. This would make it easy to keep track of the separate sub-orders.

77. With regard to claim 98, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 97. Cok further teaches, in lines 49-51 of column 9, that sub-order header, the use of "a unique identification of the customer order from which the sub-order was derived", which delimits a corresponding sub-order. Fredlund further teaches, in lines 12-14 of column 8, the printing of an address label, which is a destination identifier, along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for a destination identifier to delimit a corresponding sub-order. This would make it easy to keep track of the separate sub-orders.

78. With regard to claim 99, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 97. Fredlund further discloses, in lines 12-14 of column 8, the

printing of address labels, which inherently contains a shipping address, along with the image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the destination identifier to comprise a shipping address in order for the order to be properly shipped.

79. With regard to claim 100, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 94. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. This is a process of instantiating a copy of the image for each recipient designated to receive a print of that image.

80. With regard to claim 101, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 100. Fredlund further discloses, in lines 26-30 of column 7, the producing of Photo CD's from the ordered images. This is a case wherein an instantiated copy comprises a digital image file since Photo CD's must contain digital image files.

81. With regard to claim 102, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 94. Cok further discloses, in lines 62 of column 2 through 7 of column 3, that a processor, which is a first entity, divides an order into sub-orders, and a plurality of output systems, one of which is a second entity, generates one or more image copies.

82. With regard to claim 104, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 102. Fredlund further teaches, in lines 19-41 of column 3, the use of a retail outlet, which is inherently a goods / service provider, to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a goods / service provider enterprise in order to provide easy access to the customer.

83. With regard to claim 105, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 104. Fredlund further teaches, in lines 19-41 of column 3, the use of a drugstore or supermarket to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a supermarket, a drugstore, a post office, or an online grocer in order to provide easy access to the customer.

84. Claims 26 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Shiota. With regard to claim 26, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 25. Fredlund in view of Johnson in further view of Cok does not disclose wherein the first entity comprises a photo-finishing enterprise. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server, a first entity that is a photo-finishing lab, receives an order for image prints and a separate laboratory server, a second entity, prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the first entity to comprise a photo-finishing enterprise since a photo-finishing enterprise is well suited to process the image order.

85. With regard to claim 103, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 102. Fredlund in view of Johnson in further view of Cok does not disclose wherein the first entity comprises a photo-finishing enterprise. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server, a first entity that is a photo-finishing lab, receives an order for image prints and a separate laboratory server, a second entity, prints and distributes the ordered prints. It would

have been obvious to one of ordinary skill in the art at the time the invention was made for the first entity to comprise a photo-finishing enterprise since a photo-finishing enterprise is well suited to process the image order.

86. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Clark (4,854,094). Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 25. Fredlund in view of Johnson in further view of Cok does not disclose shipping unrelated goods along with a recipient's printed image copies. Clark teaches, in lines 6-8 of column 8, a method of shipping unrelated goods along with a previously established order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient. This would reduce the total shipping cost.

87. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Stancato (5,056,823). Fredlund in view of Johnson discloses the invention as stated in claim 39. Fredlund in view of Johnson does not disclose the set of digital content comprising photo-album pages. Stancato teaches, in lines 6-15 of column 1, the use of a photo-album for displaying images. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise photo-album pages bearing one or more digital images. This would achieve an overall aesthetically appealing display of the images.

88. Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Tackbary. With regard to claim 49, Fredlund in view of

Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose wherein the physical manifestation of the set of digital content comprises cards bearing the graphical and/or textual content. Tackbary teaches, in lines 25-40 of column 9, the selection of cards bearing graphical or textual content. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise cards bearing the graphical and/or textual content. This would allow the user to send images in the form of cards, which are considered a socially important way to keep in touch.

89. With regard to claim 50, Fredlund in view Johnson in further view of Tackbary discloses the invention as stated in claim 49. Tackbary further teaches, in line 13 of column 1, the use of social expression cards, which are greeting cards. Tackbary further teaches, in lines 22-31 of column 5, the occasions of holidays for sending cards. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the cards bearing the graphical and/or textual content to comprise one or more of the following: greeting cards, holiday cards, announcements, playing cards, post cards, thank you cards, or invitations. This would allow the user to select an appropriate card for the image being sent and occasion it is being sent for.

90. With regard to claim 51, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose wherein the physical manifestation of the set of digital content comprises cards bearing the graphical and/or textual content. Tackbary teaches, in lines 25-40 of column 9, the selection of cards bearing graphical or textual content. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise cards bearing the graphical

and/or textual content. This would allow the user to send images in the form of cards, which are considered a socially important way to keep in touch.

91. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Brewen, *et al.* (4,872,706). With regard to claim 52, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose the manifestation of the set of digital content comprising advertisements. Brewen teaches an advertisement bearing graphical content, as shown in figure 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise advertisements bearing the graphical and/or textual content. This would provide a novel way for advertisers to get the name and image of their products or services before consumers.

92. With regard to claim 53, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose the manifestation of the set of digital content comprising coupons. Brewen teaches a coupon bearing graphical content, as shown in figure 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise coupons bearing the graphical and/or textual content. This would provide a novel way for advertisers to get the name and image of their products or services before consumers in the form of a coupon.

93. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Stancato. With regard to claim 54, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose the set of digital content comprising a bound volume. Stancato teaches, in lines 6-15 of

column 1, the use of a photo-album, which is a bound volume, for displaying images. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise a bound volume bearing the graphical and/or textual content. This would achieve an overall aesthetically appealing display of the content.

94. With regard to claim 55, Fredlund in view of Johnson in further view of Stancato discloses the invention as stated in claim 54. Stancato teaches, in lines 6-15 of column 1, the use of a photo-album, which is a bound volume, for displaying images. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise a photo-album bearing the graphical and/or textual content. This would achieve an overall aesthetically appealing display of the content.

95. With regard to claim 56, Fredlund in view of Johnson in further view of Stancato discloses the invention as stated in claim 54. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the bound volume to comprise a travel book since various uses of the bound volume are possible.

96. Claims 59-61, 71-75, 77 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 59, Fredlund discloses a computer-implemented method of distributing photographic prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address

before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further discloses, in lines 45 of column 4 through 6 of column 6, the setting of one or more print parameters. One difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for a single received order to specify a plurality of recipients, and for each specified recipient, a set of one or more images associated with that recipient. This would streamline the order process. Fredlund also does not disclose dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different specified recipient, each sub-order comprising an instance of each digital image associated with the recipient corresponding to the sub-order. This would allow for each recipient's order to be prepared separately. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the instantiated digital images in each of the sub-orders according to the print parameters associated with each image. This step is necessary in order to complete the order.

Fredlund further discloses, in lines 42-44 of column 2, the step of sending the prints to the designated recipients.

97. With regard to claim 60, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses, in lines 34-44 of column 2, the method of receiving an order through the use of a computer, which comprises receiving interactive input from a user of a computer system.

98. With regard to claim 61, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 60. Fredlund further teaches, in lines 34-36 of column 2, that the computer system comprises the user's personal computer system.

99. With regard to claim 71, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Cok further teaches, in lines 49-51 of column 9, the use of a sub-order header for each sub-order that includes "a unique identification of the customer order from which the sub-order was derived". Fredlund further teaches, in lines 12-14 of column 8, the printing of address labels along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a destination identifier that identifies the specified recipient for a corresponding run of prints. This would make it easy to keep track of the separate sub-orders.

100. With regard to claim 72, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 71. Cok further teaches, in lines 49-51 of column 9, that sub-order header, the use of "a unique identification of the customer order from which the sub-order was derived", which inherently delimits a corresponding sub-order. Fredlund further teaches, in lines 12-14 of column 8, the printing of an address label, which is inherently a destination

identifier, along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for a destination identifier to delimit a corresponding sub-order. This would make it easy to keep track of the separate sub-orders.

101. With regard to claim 73, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 71. Fredlund further teaches, in lines 12-14 of column 8, the printing of address labels, which inherently contains a shipping address, along with the image prints.

102. With regard to claim 74, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further teaches, in lines 34-35 of column 6 that "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This shows that the print parameters of a first image in a sub-order could differ from the print parameters of a second image in the sub-order if the user so desired.

103. With regard to claim 75, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Cok further discloses, in lines 62 of column 2 through 7 of column 3, that a processor, which is a first entity, divides an order into sub-orders, and a plurality of output systems, one of which is a second entity, generates one or more image copies.

104. With regard to claim 77, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 75. Fredlund further teaches, in lines 19-41 of column 3, the use of a retail outlet, which is inherently a goods / service provider, to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a goods / service provider enterprise in order to provide easy access to the customer.

105. With regard to claim 78, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 77. Fredlund further teaches, in lines 19-41 of column 3, the use of a drugstore or supermarket to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a supermarket, a drugstore, a post office, or an online grocer in order to provide easy access to the customer.

106. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Klees (5,652,936). Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 60. Klees teaches, in lines 30-45 of column 2, the use of an "automatic photofinishing apparatus", which is inherently a public entry terminal, for submitting photographic print orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the computer system to comprise a public entry terminal. This would allow for users without personal computers to utilize the service.

107. Claims 63-65 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 63, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

108. With regard to claim 64, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses, in lines 42-44 of column 2, the method where the "photofinisher completes the order and sends the prints to the designated recipient". This is an integrated process for printing and distributing.

109. With regard to claim 65, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses, in lines 28-44 of column 2, the method wherein a single entity, i.e. the photofinisher, performs the steps of receiving the order, completing the order (printing) and sending the prints (distributing). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the steps of receiving, dividing, printing and distributing to be performed by a single entity. This would provide for an efficient process.

110. With regard to claim 69, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses, in lines 42-44 of column 2, the method wherein a single entity, i.e. the photofinisher, performs the steps of completing the order (printing) and sending the prints (distributing).

111. Claims 66-68 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Shiota. With regard to claim 66, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server receives an order for image prints and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the performance of

receiving, dividing, printing, and distributing to be dispersed among two or more different entities. This would provide a prompt service to a customer.

112. With regard to claim 67, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Shiota teaches, in lines 21-32 of column 2, the use of a website on the Internet through which an order is transferred from a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive an order by an enterprise providing a web front-end. This would allow for the order to be automatically received in the correct predetermined data format.

113. With regard to claim 68, Fredlund in view of Johnson in further view of Cok in further view of Shiota discloses the invention as stated in claim 67. Shiota further teaches, in lines 65 of column 1 through 9 of column 2, the method of distributing image prints wherein a center server receives a "printing service order via the network", using a web front end as described in lines 21-32 of column 2, and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for one or more of dividing, printing and distributing to be performed by a fulfillment enterprise different than the enterprise providing the web front-end. This would provide a prompt service to a customer.

114. With regard to claim 76, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 75. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server, a first entity that is a photo-finishing lab, receives an order for image prints and a separate laboratory server, a second entity, prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in

the art at the time the invention was made for the first entity to comprise a photo-finishing enterprise since a photo-finishing enterprise is well suited to process the image order.

115. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Tackbary. Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Tackbary teaches, in lines 55 of column 12 through 3 of column 13, the use of a card distribution center to print a graphical card design on blank paper stock and the delivery of said cards via a different entity, with examples of said different entity given in lines 9-11 of column 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made for printing and distributing to be performed by different entities. This would allow for both printing and distributing to be handled by an entity specifically tailored for each task respectively.

116. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Clark. Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund in view of Johnson in further view of Cok does not disclose delivering unrelated goods along with a recipient's prints. Clark teaches, in lines 6-8 of column 8, a method of shipping unrelated goods along with a previously established order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver a recipient's prints along with an unrelated order of goods / services associated with that recipient. This would reduce the total shipping cost.

117. Claim 106 rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Clark. Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 104. Fredlund in view of Johnson

in further view of Cok does not disclose delivering unrelated goods along with a recipient's printed image copies. Clark teaches, in lines 6-8 of column 8, a method of shipping unrelated goods along with a previously established order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient. This would reduce the total shipping cost.

118. Claims 116-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Shiota. With regard to claim 116, Fredlund discloses a computer-implemented method of distributing image prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. One difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for a single received order to specify a plurality of recipients, and for each specified recipient, a set of one or more images associated with that recipient. This would streamline the order process. Fredlund further discloses, in lines 18-30 of

column 7, a step of filling the order by printing the selected images. This is a step of printing at least one copy of each image in the recipient's image set for each of the plurality of recipients specified in the received order. Fredlund further discloses, in lines 42-44 of column 2, the step of sending the prints to the designated recipients. All of the above steps are performed at a first entity. Fredlund does not disclose communicating the received order to a facility corresponding to a second entity and printing the images there. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server receives an order for image prints and communicates the order to a separate laboratory server that prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made to communicate the received order to a facility corresponding to a second entity and at the second entity's facility, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set. This would provide a prompt service to a customer.

119. With regard to claim 117, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 116. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server, a first entity that is a photo-finishing lab, receives an order for image prints and a separate laboratory server, a second entity, prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the first entity to comprise a photo-finishing enterprise since a photo-finishing enterprise is well suited to process the image order.

120. With regard to claim 118, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 116. Fredlund further teaches, in lines 19-41 of column 3, the

use of a retail outlet, which is inherently a goods / service provider, to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a goods / service provider enterprise in order to provide easy access to the customer.

121. With regard to claim 119, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 118. Fredlund further teaches, in lines 19-41 of column 3, the use of a drugstore or supermarket to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the second entity to comprise a supermarket, a drugstore, a post office, or an online grocer in order to provide easy access to the customer.

122. Claim 120 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Shiota in further view of Clark. Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 118. Fredlund in view of Johnson in further view of Shiota does not disclose delivering unrelated goods along with a recipient's printed image copies. Clark teaches, in lines 6-8 of column 8, a method of shipping unrelated goods along with a previously established order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient. This would reduce the total shipping cost.

123. Claims 121-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Shiota in further view of Cok. With regard to claim 121, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim

116. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. This would allow for each recipient's order to be prepared separately.

124. With regard to claim 122, Fredlund in view of Johnson in further view of Shiota in further view of Cok discloses the invention as stated in claim 121. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a set of one or more images in each sub-order in order to fulfill each recipient's order.

125. With regard to claim 123, Fredlund in view of Johnson in further view of Shiota in further view of Cok discloses the invention as stated in claim 121. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. This will print a run of prints associated with a specified recipient since the images associated with each recipient are contained in the order.

126. With regard to claim 124, Fredlund in view of Johnson in further view of Shiota in further view of Cok discloses the invention as stated in claim 123. Cok further teaches, in lines 49-51 of column 9, the use of a sub-order header for each sub-order that includes "a unique identification of the customer order from which the sub-order was derived". Fredlund further teaches, in lines 12-14 of column 8, he printing of address labels along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

print a destination identifier that identifies the specified recipient for a corresponding run of prints. This would make it easy to keep track of the separate sub-orders.

127. With regard to claim 125, Fredlund in view of Johnson in further view of Shiota in further view of Cok discloses the invention as stated in claim 124. Cok further teaches, in lines 49-51 of column 9, that sub-order header, the use of "a unique identification of the customer order from which the sub-order was derived", which inherently delimits a corresponding sub-order. Fredlund further teaches, in lines 12-14 of column 8, the printing of an address label, which is inherently a destination identifier, along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for a destination identifier to delimit a corresponding sub-order. This would make it easy to keep track of the separate sub-orders.

128. With regard to claim 126, Fredlund in view of Johnson in further view of Shiota in further view of Cok discloses the invention as stated in claim 124. Fredlund further discloses, in lines 12-14 of column 8, the printing of address labels, which inherently contains a shipping address, along with the image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the destination identifier to comprise a shipping address in order for the order to be properly shipped.

129. Claims 127, 130 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Klees in further view of Shiota. With regard to claim 127, Fredlund discloses a computer-implemented method of distributing image prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the

use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. One difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images at the photofinisher, which is inherently a photo-finishing facility. This is inherently printing at the photo-finishing facility at least one copy of each image in the recipient's image set for each of the plurality of recipients specified in the received order. Fredlund further discloses, in lines 42-44 of column 2, the step of distributing the printed image copies to their respective associated recipients. Fredlund does not disclose the receiving of an order from a public entry terminal and transmitting the received order from the public entry terminal to a photo-finishing facility. Klees teaches, in lines 30-45 of column 2, the use of an "automatic photofinishing apparatus", which is inherently a public entry terminal, for submitting photographic print orders. Shiota teaches, in lines 45-62 of column 7, the method of receiving images at a minilab and

transmitting the images to a center server, which is a photo-finishing lab. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund such that an an order could be submitted from a user at a public entry terminal, such as the "automatic photofinishing apparatus" of Klees and transmitted from the public entry terminal to a photo-finishing lab in accordance with Shiota. Allowing users to submit orders via a public entry terminal, as taught by Klees, would provide access to the print ordering service of Fredlund and Johnson for customers without their own personal computers to place orders from.

130. With regard to claim 130, Fredlund in view of Johnson in further view of Klees in further view of Shiota discloses the invention as stated in claim 127. Klees further teaches, in lines 30-35 of column 2, "a touch screen video display 14 (for example, a CRT) for displaying customer order instructions and for entering customer order data by the customer". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the public entry terminal to comprise a method of receiving manual input specifying the plurality of recipients and the set of one or more images associated with each recipient in order for the user to input his order.

131. With regard to claim 131, Fredlund in view of Johnson in further view of Klees in further view of Shiota discloses the invention as stated in claim 127. Klees further discloses in claim 1 "a kiosk" for receiving a print order.

132. Claims 128-129 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Klees in further view of Shiota in further view of Ohtsuka (EPO application # 98118497.1). With regard to claim 128, Fredlund in view of Johnson in further view of Klees in further view of Shiota discloses the invention as stated in claim 127.

Ohtsuka teaches, in lines 6-7 of page 7, that an order file for image prints "may be brought in to the laboratory directly in the form of a recording medium 12 such as a floppy disc". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the order from receiving of the user at the public entry terminal to comprise reading digital images from a computer-readable medium provided to the public-entry terminal. This would provide access for users without direct access to the Internet.

133. With regard to claim 129, Fredlund in view of Johnson in further view of Klees in further view of Shiota discloses the invention as stated in claim 127. Ohtsuka teaches, in lines 6-7 of page 7, that an order file for image prints "may be brought in to the laboratory directly in the form of a recording medium 12 such as a floppy disc". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the computer-readable storage medium to comprise a floppy disc, or diskette. This would provide access for users without direct access to the Internet.

134. Claims 133-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 133, Fredlund in view of Johnson discloses the invention as stated in claim 132. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. This would allow for each recipient's order to be prepared separately.

135. With regard to claim 134, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 133. Cok further teaches, in lines 2-5 of column 3, the step of

printing the images of each sub-order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a set of one or more images in each sub-order in order to fulfill each recipient's order.

136. With regard to claim 135, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 133. Cok further teaches, in lines 2-5 of column 3, the step of printing the images of each sub-order. This will print a run of prints associated with a specified recipient since the images associated with each recipient are contained in the order.

137. With regard to claim 136, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 135. Cok further teaches, in lines 49-51 of column 9, the use of a sub-order header for each sub-order that includes "a unique identification of the customer order from which the sub-order was derived". Fredlund further teaches, in lines 12-14 of column 8, he printing of address labels along with image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a destination identifier that identifies the specified recipient for a corresponding run of prints. This would make it easy to keep track of the separate sub-orders.

138. With regard to claim 137, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 136. Cok further teaches, in lines 49-51 of column 9, that sub-order header, the use of "a unique identification of the customer order from which the sub-order was derived", which inherently delimits a corresponding sub-order. Fredlund further teaches, in lines 12-14 of column 8, the printing of an address label, which is inherently a destination identifier, along with image prints. It would have been obvious to one of ordinary skill in the art

at the time the invention was made for a destination identifier to delimit a corresponding sub-order. This would make it easy to keep track of the separate sub-orders.

139. With regard to claim 138, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 136. Fredlund further discloses, in lines 12-14 of column 8, the printing of address labels, which inherently contains a shipping address, along with the image prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the destination identifier to comprise a shipping address in order for the order to be properly shipped.

140. With regard to claim 139, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 133. Fredlund further teaches, in lines 34-35 of column 6 that "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This inherently shows that the print parameters of a first image in a sub-order could differ from the print parameters of a second image in the sub-order if the user so desired.

141. With regard to claim 140, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 139. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

142. With regard to claim 141, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 133. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. This is a process of instantiating a copy of the images. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to instantiate a copy of the image for each recipient designated to receive a print of that image for each image in the received order when dividing the received order in to the plurality of sub-orders. This step is necessary in order to produce the image copies to be delivered.

143. With regard to claim 142, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 141. Fredlund further discloses, in lines 26-30 of column 7, the producing of Photo CD's from the ordered images. This is a case wherein an instantiated copy comprises a digital image file since Photo CD's must contain digital image files.

144. With regard to claim 143, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 132. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. This allows for the images in a first recipient's image set to differ from the images in a second recipient's image set.

145. With regard to claim 144, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 132. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This shows that if so desired, a user could select print parameters of a first recipient's image set that differ from printing parameters of a second recipient's image set.

146. With regard to claim 145, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 144. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is inherently a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

147. With regard to claim 146, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 132. Fredlund further discloses, in lines 63 of column 4 through 15 of column 6, the setting of various print parameters for an ordered image. Fredlund further states, in lines 34-35 of column 6, that when an order for an image is placed, "The settings and image selected on screen 50 remain the same unless specifically changed by the user." This shows teaches that if so desired, a user could select print parameters that differ among images within an image set.

148. Claims 147-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 147, Fredlund discloses a computer-implemented method of processing an order for image prints, which are inherently physical manifestations of digital content. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images from a digital image file, which is inherently a set of digital content, to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. One difference between Fredlund

and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images, which is inherently generating a physical manifestation of the digital content in the recipient's digital content set for each of the plurality of recipients specified in the received order. Fredlund does not disclose dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient, by instantiating a digital copy of the digital content for each recipient designated to receive a physical manifestation of that digital content. This would allow for each recipient's order to be prepared separately and thus accurately.

149. With regard to claim 148, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. Fredlund further discloses the invention as stated in claim 39 wherein the set of digital content comprises one or more digital images, as stated in lines 38-

47 of column 5 and the physical manifestation inherently comprises a photographic print of the digital image

150. With regard to claim 149, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. Fredlund further discloses, in lines 42-44 of column 2, the step of sending the prints, which are inherently the physical manifestations, to the designated recipients.

151. With regard to claim 150, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. Cok further discloses, in lines 62 of column 2 through 7 of column 3, that a processor, which is a first entity, receives and divides an order into sub-orders, and a plurality of output systems, one of which is a second entity, generates one or more image copies.

152. With regard to claim 151, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 150. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server, a first entity that is a photo-finishing lab, receives an order for image prints and a separate laboratory server, a second entity, prints and distributes the ordered prints. Fredlund further teaches, in lines 19-41 of column 3, the use of a retail outlet, which is inherently a goods / service provider, to distribute orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the first entity to comprise a photo-finishing enterprise and the second entity to comprise a goods / service provider enterprise.

153. With regard to claim 152, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. It would have been obvious to one of ordinary skill in the

art at the time the invention was made for dividing and generating to be performed by a single entity. This would provide for an efficient process.

154. With regard to claim 153, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. Cok further discloses, in lines 62 of column 2 through 7 of column 3, that a processor, which is a first entity, receives and divides an order into sub-orders, and a plurality of output systems, one of which is a second entity, generates one or more image copies.

155. Claims 154 and 155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok in further view of Shiota. With regard to claim 154, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 147. Shiota teaches, in lines 21-32 of column 2, the use of a website on the Internet through which an order is transferred from a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive an order by an enterprise providing a web front-end. This would allow for the order to be automatically received in the correct predetermined data format.

156. With regard to claim 155, Fredlund in view of Johnson in further view of Cok in further view of Shiota discloses the invention as stated in claim 154. Shiota further teaches, in lines 65 of column 1 through 9 of column 2, the method of distributing image prints wherein a center server receives a "printing service order via the network" using a web front end as described in lines 21-32 of column 2, and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made

for printing or distributing, or both, to be performed by a fulfillment enterprise different than the enterprise providing the web front-end. This would provide a prompt service to a customer.

Response to Arguments

1. Applicant's arguments filed 10/1/03 have been fully considered but they are not persuasive. Applicant argues that the combination of Fredlund and Johnson is invalid since Johnson discloses a framework for an electronic catalog with standardized products, whereas Fredlund discloses a system for ordering personalized image prints. Applicant argues that one skilled in the art would not have combined these references since the resulting combination would not have resulted in an operable system since there is no common list of products/services in the Fredlund reference as there is in the Johnson reference. However, the Johnson reference is only used to apply the narrow teaching, found in lines 60-62 of column 22, that it is known in the prior art for a single order to specify a plurality of recipients and order items. As this is the only claimed element lacking from Fredlund, the Examiner maintains that the combination is proper.

2. Applicant argues that the combination of Fredlund and Johnson was done using selective hindsight and that there was no suggestion or motivation in Johnson to modify Fredlund. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170

USPQ 209 (CCPA 1971). It would have been obvious to one of ordinary skill in the art that the efficiency of the ordering process of Fredlund could be improved by allowing a single order to specify a plurality of recipients as taught by Johnson. Fredlund contains all the elements of the claimed invention except that in order for a user of the Fredlund invention to send images to multiple addresses, the user must submit multiple orders and therefore reenter certain redundant information. One skilled in the art would find it obvious to modify Fredlund so that this redundant information needed to be entered only once by encapsulating multiple shipping addresses and order items into a single order. As such, the Examiner maintains that selective hindsight was not used in the combination of the Fredlund and Johnson references.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Foster whose telephone number is (703)305-1900. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

JF

David K Moore

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600